

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Labrec *et al.* CONFIRMATION No.: 4087
SERIAL NUMBER : 10/677,092 EXAMINER: Sanza L. McClendon
FILING DATE : September 30, 2003 ART UNIT: 1796
FOR : INCREASING THERMAL CONDUCTIVITY OF HOST POLYMER USED WITH LASER
ENGRAVING METHODS AND COMPOSITIONS

Via EFS

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(b)**

Applicants request reconsideration of patent term adjustment for the above-referenced application. Also enclosed is the two-hundred dollar fee as required by 37 C.F.R. § 1.18(e).

Applicants received a Notice of Allowance and Fees Due from the U.S. Patent and Trademark Office, mailed on September 21, 2009, which stated that the Patent Term Adjustment under 35 U.S.C. 154(b) to date is 18 days. This Request is submitted in view of the decision by the U.S. District Court decision in *Wyeth v. Dudas* (D.D.C. 2008) on September 30, 2008 as well as Applicants' duty under 37 C.F.R. 1.765.

By this paper, Applicants hereby petition the U.S. Patent and Trademark Office for reconsideration of the patent term adjustment calculation to **48 days** based on the facts provided herein.

This patent application was filed on September 30, 2003 and is therefore subject to the patent term adjustment procedures set forth in 37 C.F.R. §§ 1.702 to 1.705 for applications filed on or after May 29, 2000.

On December 23, 2003, the Office mailed a Notice to File Missing Parts.

On May 26, 2004, Applicants filed a Response to Notice to File Missing Parts. This Response was filed 64 days after the date that is three months after the mailing date of the Office Action. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 64 day Applicant delay.

On March 18, 2005, the Office mailed a Notice of Allowance. The Notice was mailed 108 days after the date that is fourteen-month requirement for mailing of the first action after the

date on which the application was filed under 35 U.S.C. §111(a). As shown in the PAIR Patent Term Adjustment printout submitted as Exhibit A, the number of days of Patent Term Adjustment accounts for the 108 day Office delay.

On June 20, 2005, Applicants filed a Request for Continued Examination. This Request was filed 2 days after the date that is three months after the mailing date of the Notice. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 2 day Applicant delay.

On July 1, 2005, Applicants filed a supplemental Information Disclosure Statement, which qualified as a submission under 37 C.F.R. 1.704(c)(8). As this paper was not expressly requested by the Examiner and was filed after a Response had been filed, the period of adjustment begins on the day after the date the initial reply was filed, *i.e.* June 21, 2005, and ends on the date that the other paper was filed, *i.e.* July 1, 2005, which is 11 days. This delay is not accounted for by the U.S. Patent Office. In accordance with 37 C.F.R. 1.765, Applicants' duty of candor and good faith toward the Office, Applicants believe an additional **11 days** of Applicant delay should be applied.

On January 19, 2006, the Office mailed a Notice of Allowance. This Notice was mailed 91 days after the date that is four months from the filing of the reply filed under 35 U.S.C. §132. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 91 day Office delay.

On April 24, 2006, the Office receive a Request for Continued Examination. This Request was received 5 days after the date that is three months after the mailing date of the Notice. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 5 day Applicant delay.

On July 10, 2006, the Office mailed a Notice of Allowance. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On October 10, 2006, Applicants filed a Request for Continued Examination. This Request was filed within three months of the mailing date of the Notice.

On October 24, 2006, Applicants filed a supplemental Information Disclosure Statement, which qualified as a submission under 37 C.F.R. 1.704(c)(8). As this paper was not expressly requested by the Examiner and was filed after a Response had been filed, the period of adjustment begins on the day after the date the initial reply was filed, *i.e.* October 11, 2006, and

ends on the date that the other paper was filed, *i.e.* October 24, 2006, which is 14 days. This delay is not accounted for by the U.S. Patent Office. In accordance with 37 C.F.R. 1.765, Applicants' duty of candor and good faith toward the Office, Applicants believe an additional **14 days** of Applicant delay should be applied.

On November 8, 2006, the Office mailed a Notice of Allowance. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On February 8, 2007, Applicants filed a Request for Continued Examination. This Request was filed within three months of the mailing date of the Notice.

On March 8, 2007, the Office mailed a Notice of Allowance. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On June 8, 2007, Applicants filed a Request for Continued Examination. This Request was filed within three months of the mailing date of the Notice.

On June 20, 2007, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On November 20, 2007, Applicants filed a Response to Non-Final Office Action with a two month extension of time. This Response was filed 61 days after the date that is three months after the mailing date of the Action. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 61 day Applicant delay. Applicants note that this delay was recorded and counted twice by the Patent Office.

On January 17, 2008, the Office mailed a Notice of Allowance. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On April 21, 2008, the Office receive a Request for Continued Examination. This Request was received 4 days after the date that is three months after the mailing date of the Notice. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 4 day Applicant delay. Applicants note that this delay was recorded and counted twice by the Patent Office.

On May 13, 2008, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On September 15, 2008, Applicants filed a Response to Non-Final Office Action with a one month extension of time. This Response was filed 33 days after the date that is three months after the mailing date of the Action. As shown in Exhibit A, the number of days of Patent Term

Adjustment accounts for the 33 day Applicant delay. Applicants note that this delay was recorded and counted twice by the Patent Office.

On February 27, 2009, the Office mailed a Notice of Allowance. This Notice was mailed 43 days after the date that is four months from the filing of the reply filed under 35 U.S.C. §132. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 43 day Office delay. Applicants note that this delay was recorded and counted twice by the Patent Office.

On May 27, 2009, Applicants filed a Request for Continued Examination. This Request was filed within three months of the mailing date of the Notice.

On June 17, 2009, the Office mailed a Notice of Allowance. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On July 20, 2009, Applicants filed a Request for Continued Examination. This Request was filed within three months of the mailing date of the Notice.

On September 21, 2009, the Office mailed the Notice of Allowance/Notice of Allowability, and the Determination of Patent Term Adjustment for this application. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132. The Determination of Patent Term Adjustment noted an adjustment period for this patent application of 18 days. As indicated in Exhibit A, the Office delay for this application is indicated as 285 days and Applicants' delay is 267 days.

According to the provisions of 37 C.F.R. §1.702(b), Applicants are entitled to Patent Term Adjustment for the failure of the Office to issue the patent within three years after the date on which the application was filed. Under 37 C.F.R. §1.702(b)(1)-(5), Applicants are entitled to this adjustment for any time other than time consumed by continued examination of the application requested by the applicant under section 132(b), beginning on the date on which a Request for Continued Examination was filed, June 20, 2005, and ending on the date the patent issues.

The amount of the Adjustment under 37 C.F.R. §1.702(b) is calculated from October 1, 2006 (*i.e.*, the day after the date that is three years from the date that the application was filed), through the day before the date the Request for Continued Examination was filed, *i.e.* June 20, 2005, subtracting only time legitimately attributable to Applicant delay. Applicants note that the Request for Examination was filed before October 1, 2006.

Applicants have calculated the Patent Term Adjustment based on 37 C.F.R. 1.702(a), 37 C.F.R. 1.702(b) and 37 C.F.R. 1.704 through the mailing of the Notice of Allowance. The total calculation of Patent Term Adjustment is as follows: Office delay under 37 CFR 1.702(a) is $108+91+43 = 242$ days; Office Delay under 37 CFR 1.702(b) is 0 days; and Applicant delay under 37 CFR 1.704(c) is: $64+2+11+5+14+61+4+33 = 194$ days, adjustment is **$242+0-194 = 48$ days.**

Applicants reserve the right to request any further patent term adjustment based on the actual issue date of the instant application.

If the Office would like to discuss any aspect of this filing, the Office representative assigned to process this request is welcome to call the undersigned attorneys. No additional fees are believed to be due by submission of this paper. However, the Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 38820-534001US.

Respectfully submitted,

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Date: December 17, 2009

Exhibit A

10/677,092

**INCREASING THERMAL CONDUCTIVITY OF HOST POLYMER USED WITH 12-14-
LASER ENGRAVING METHODS AND COMPOSITIONS**

2009::17:31:03

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/677,092

Filing or 371(c) Date:	09-30-2003	USPTO Delay (PTO) Delay (days):	285
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	267
Post-Issue Petitions (days):	+0	Total PTA (days):	18
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
09-21-2009	Mail Notice of Allowance		
08-08-2009	Document Verification		
08-08-2009	Notice of Allowance Data Verification Completed		
07-20-2009	Information Disclosure Statement considered		
07-20-2009	Information Disclosure Statement (IDS) Filed		
07-28-2009	Date Forwarded to Examiner		
07-20-2009	Request for Continued Examination (RCE)		
07-28-2009	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
07-20-2009	Information Disclosure Statement (IDS) Filed		
07-20-2009	Workflow - Request for RCE - Begin		
06-17-2009	Mail Notice of Allowance		
06-17-2009	Mail Notice of Allowance		
06-17-2009	Document Verification		
06-17-2009	Document Verification		
06-17-2009	Notice of Allowance Data Verification Completed		
06-17-2009	Notice of Allowance Data Verification Completed		
05-27-2009	Information Disclosure Statement considered		
05-27-2009	Information Disclosure Statement considered		
06-02-2009	Change in Power of Attorney (May Include Associate POA)		
06-02-2009	Change in Power of Attorney (May Include Associate POA)		
05-27-2009	Reference capture on IDS		
05-27-2009	Reference capture on IDS		
05-27-2009	Information Disclosure Statement (IDS) Filed		
05-27-2009	Information Disclosure Statement (IDS) Filed		
05-29-2009	Date Forwarded to Examiner		
05-29-2009	Date Forwarded to Examiner		
05-27-2009	Request for Continued Examination (RCE)		
05-27-2009	Request for Continued Examination (RCE)		
05-29-2009	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
	DISPOSAL FOR A RCE/CPA/129 (express abandonment if		

05-29-2009	CPA)		
05-29-2009	Correspondence Address Change		
05-29-2009	Correspondence Address Change		
05-27-2009	Information Disclosure Statement (IDS) Filed		
05-27-2009	Information Disclosure Statement (IDS) Filed		
05-27-2009	Workflow - Request for RCE - Begin		
05-27-2009	Workflow - Request for RCE - Begin		
02-27-2009	Mail Examiner's Amendment		
02-27-2009	Mail Examiner's Amendment		
02-27-2009	Mail Notice of Allowance	43	
02-27-2009	Mail Notice of Allowance	43	
10-21-2008	Examiner's Amendment Communication	⬆	
10-21-2008	Examiner's Amendment Communication	⬆	
10-14-2008	Document Verification	⬆	
10-14-2008	Document Verification	⬆	
10-14-2008	Notice of Allowance Data Verification Completed	⬆	
10-14-2008	Notice of Allowance Data Verification Completed	⬆	
09-15-2008	Information Disclosure Statement considered	⬆	
09-15-2008	Information Disclosure Statement considered	⬆	
09-15-2008	Information Disclosure Statement (IDS) Filed	⬆	
09-15-2008	Information Disclosure Statement (IDS) Filed	⬆	
10-09-2008	Date Forwarded to Examiner	⬆	
10-09-2008	Date Forwarded to Examiner	⬆	
09-15-2008	Response after Non-Final Action		33
09-15-2008	Response after Non-Final Action		33
09-15-2008	Request for Extension of Time - Granted	⬆	
09-15-2008	Request for Extension of Time - Granted	⬆	
09-15-2008	Information Disclosure Statement (IDS) Filed	⬆	
09-15-2008	Information Disclosure Statement (IDS) Filed	⬆	
05-13-2008	Mail Non-Final Rejection	⬆	
05-13-2008	Mail Non-Final Rejection	⬆	
05-12-2008	Non-Final Rejection		
05-12-2008	Non-Final Rejection		
04-21-2008	Information Disclosure Statement considered		
04-21-2008	Information Disclosure Statement considered		
04-21-2008	Information Disclosure Statement (IDS) Filed		
04-21-2008	Information Disclosure Statement (IDS) Filed		
05-01-2008	Date Forwarded to Examiner		
05-01-2008	Date Forwarded to Examiner		
04-21-2008	Request for Continued Examination (RCE)		4
04-21-2008	Request for Continued Examination (RCE)		4

05-01-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	⬆
05-01-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	⬆
04-21-2008	Information Disclosure Statement (IDS) Filed	⬆
04-21-2008	Information Disclosure Statement (IDS) Filed	⬆
04-21-2008	Workflow - Request for RCE - Begin	⬆
04-21-2008	Workflow - Request for RCE - Begin	⬆
01-17-2008	Mail Notice of Allowance	⬆
01-17-2008	Mail Notice of Allowance	⬆
01-16-2008	Document Verification	
01-16-2008	Document Verification	
01-16-2008	Notice of Allowance Data Verification Completed	
01-16-2008	Notice of Allowance Data Verification Completed	
11-29-2007	Date Forwarded to Examiner	
11-29-2007	Date Forwarded to Examiner	
11-20-2007	Response after Non-Final Action	61
11-20-2007	Response after Non-Final Action	61
11-20-2007	Request for Extension of Time - Granted	⬆
11-20-2007	Request for Extension of Time - Granted	⬆
10-04-2007	Case Docketed to Examiner in GAU	⬆
10-04-2007	Case Docketed to Examiner in GAU	⬆
06-20-2007	Mail Non-Final Rejection	⬆
06-20-2007	Mail Non-Final Rejection	⬆
06-18-2007	Non-Final Rejection	
06-18-2007	Non-Final Rejection	
06-08-2007	Information Disclosure Statement considered	
06-08-2007	Information Disclosure Statement considered	
06-08-2007	Reference capture on IDS	
06-08-2007	Reference capture on IDS	
06-08-2007	Information Disclosure Statement (IDS) Filed	
06-08-2007	Information Disclosure Statement (IDS) Filed	
06-13-2007	Date Forwarded to Examiner	
06-13-2007	Date Forwarded to Examiner	
06-08-2007	Request for Continued Examination (RCE)	
06-08-2007	Request for Continued Examination (RCE)	
06-13-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
06-13-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
06-08-2007	Information Disclosure Statement (IDS) Filed	
06-08-2007	Information Disclosure Statement (IDS) Filed	
06-08-2007	Workflow - Request for RCE - Begin	

06-08-2007	Workflow - Request for RCE - Begin	
03-08-2007	Mail Notice of Allowance	
03-08-2007	Mail Notice of Allowance	
03-01-2007	Notice of Allowance Data Verification Completed	
10-24-2006	Information Disclosure Statement considered	
02-08-2007	Information Disclosure Statement considered	
02-08-2007	Reference capture on IDS	
02-08-2007	Information Disclosure Statement (IDS) Filed	
02-08-2007	Information Disclosure Statement (IDS) Filed	
02-12-2007	Date Forwarded to Examiner	
02-08-2007	Request for Continued Examination (RCE)	
02-12-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
02-08-2007	Workflow - Request for RCE - Begin	
11-08-2006	Mail Notice of Allowance	
11-07-2006	Notice of Allowance Data Verification Completed	
11-07-2006	Case Docketed to Examiner in GAU	
10-24-2006	Information Disclosure Statement (IDS) Filed	
10-24-2006	Information Disclosure Statement (IDS) Filed	
10-10-2006	Information Disclosure Statement considered	
10-10-2006	Reference capture on IDS	
10-10-2006	Information Disclosure Statement (IDS) Filed	
10-10-2006	Information Disclosure Statement (IDS) Filed	
10-13-2006	Date Forwarded to Examiner	
10-10-2006	Request for Continued Examination (RCE)	
10-13-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
10-10-2006	Workflow - Request for RCE - Begin	
07-10-2006	Mail Notice of Allowance	
06-27-2006	Notice of Allowance Data Verification Completed	
04-24-2006	Information Disclosure Statement considered	
06-09-2006	Date Forwarded to Examiner	
04-24-2006	Request for Continued Examination (RCE)	5
06-09-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	↑
04-24-2006	Reference capture on IDS	↑
04-24-2006	Information Disclosure Statement (IDS) Filed	↑
04-24-2006	Information Disclosure Statement (IDS) Filed	↑
04-24-2006	Workflow - Request for RCE - Begin	↑
01-19-2006	Mail Notice of Allowance	91
01-09-2006	Notice of Allowance Data Verification Completed	↑
06-20-2005	Information Disclosure Statement considered	↑

07-01-2005	Information Disclosure Statement considered	⬆	
06-20-2005	Reference capture on IDS	⬆	
06-20-2005	Information Disclosure Statement (IDS) Filed	⬆	
06-20-2005	Information Disclosure Statement (IDS) Filed	⬆	
12-22-2005	Date Forwarded to Examiner	⬆	
06-20-2005	Request for Continued Examination (RCE)		2
12-22-2005	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	⬆	
07-01-2005	Reference capture on IDS	⬆	
07-01-2005	Information Disclosure Statement (IDS) Filed	⬆	
07-01-2005	Information Disclosure Statement (IDS) Filed	⬆	
06-20-2005	Workflow - Request for RCE - Begin	⬆	
03-18-2005	Mail Notice of Allowance	108	
03-17-2005	Notice of Allowance Data Verification Completed	⬆	
05-26-2004	Preliminary Amendment	⬆	
07-08-2004	Case Docketed to Examiner in GAU	⬆	
07-08-2004	IFW TSS Processing by Tech Center Complete	⬆	
06-10-2004	Application Return from OIPE	⬆	
06-10-2004	Application Return TO OIPE	⬆	
06-10-2004	Application Dispatched from OIPE	⬆	
06-10-2004	Application Is Now Complete	⬆	
05-26-2004	Payment of additional filing fee/Preexam		64
05-26-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	⬆	
12-23-2003	Notice Mailed--Application Incomplete--Filing Date Assigned	⬆	
12-11-2003	Cleared by OIPE CSR		
11-14-2003	IFW Scan & PACR Auto Security Review		
09-30-2003	Initial Exam Team nn		

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